

REMARKS

By this amendment, Applicants have amended claims 1 and 9. Support for the amendments to claim 1 and 9 may be found in the specification at, for example, page 8, paragraphs [0036]-[0038] and pages 17-18, paragraphs [0064]-[0065]. Claims 1-7 and 9-16 remain pending and under current examination.

In the Office Action¹, the Examiner rejected claims 9-16 under 35 U.S.C. § 101; rejected claim 9 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,643,661 to Polizzi et al. ("Polizzi"); rejected claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Polizzi in view of U.S. Patent No. 7,124,355 to Kukkal ("Kukkal"); rejected claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over Polizzi in view of Kukkal and further in view of U.S. Patent No. 6,327,628 to Anuff et al. ("Anuff"); rejected claims 10-15 under 35 U.S.C. § 103(a) as being unpatentable over Polizzi in view of Anuff; and rejected claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Polizzi in view of Kukkal.

I. Rejection under 35 U.S.C. § 101

Claims 9-16 are rejected as being "non-statutory." Among other things, the Examiner asserts that the claims are "directed to software per se and not one of the four statutory classes." See Office Action, page 2. To advance prosecution, Applicants have amended claim 9. In view of the amendments to claim 9, Applicants respectfully request that the Examiner withdraw the rejection of claim 9 and dependent claims 10-16 under 35 U.S.C. § 101.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement of characterization in the Office Action.

II. Rejection under 35 U.S.C. § 102(e)

Applicants respectfully traverse the Examiner's rejection of claim 9 under 35 U.S.C. § 102(e) as being anticipated by Polizzi. In order to properly establish that Polizzi anticipates Applicants' claimed invention under 35 U.S.C. § 102(e), each and every element of each of the claims in issue must be found, either expressly described or under principles of inherency, in that single reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Polizzi fails to teach each and every element recited in amended independent claim 9. For example, Polizzi does not disclose a user interface tool configured to "present in the user's personal workspace a workset that defines a user's work role, the workset including at least one task and a working environment for performing the work role," as recited in amended claim 9.

Polizzi appears to relate to a system that provides "personalized portal pages on which searches can be entered and search reports can be dynamically reported." See Polizzi, Abstract. In addition, Polizzi discloses that a portal page is a "customized web page that presents data from the portal system 120 that is most relevant to a particular user" and that a portal page is a "user's primary interface to the data, reports and jobs that are resident in the portal system 120." See Polizzi, Col. 20, lines 45-50. However, Polizzi does not teach a user interface tool configured to "present in the user's personal workspace a workset that defines a user's work role, the workset including at least one

task and a working environment for performing the work role,” as recited in amended claim 9. For at least this reason, independent claim 9 is allowable over Polizzi.

III. Rejection of claim 1 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the Examiner's rejection of claim 1 under 35 U.S.C. § 103(a) as being unpatentable over Polizzi in view of Kukkal. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P.* § 2142, 8th Ed., Rev. 6 (Sept. 2007). “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P.* § 2145. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P.* § 2143.01 (III), *internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P.* § 2141.02(1), *internal citations omitted* (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966).... The factual inquiries ... [include determining the scope and content of the prior

art and] ... [a]scertaining the differences between the claimed invention and the prior art." M.P.E.P. § 2141(11). "Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art." M.P.E.P. § 2141(11).

The prior art does not teach or suggest a method comprising "presenting in the user's personal workspace a workset that defines a user's work role, the workset including at least one task and a working environment for performing the work role" as recited in amended claim 1. As discussed above, Polizzi does not teach or suggest "presenting in the user's personal workspace a workset that defines a user's work role, the workset including at least one task and a working environment for performing the work role," as recited in claim 1.

Kukkal also does not teach or suggest these elements. The Examiner alleges Kukkal teaches "the execution level page preserving the work performed before navigating to the control level page." See Office Action, page 5. However, even assuming this is correct, which Applicants do not concede, Kukkal fails to teach or suggest a method comprising "presenting in the user's personal workspace a workset that defines a user's work role, the workset including at least one task and a working environment for performing the work role," as recited in amended claim 1.

Accordingly, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 1. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, a *prima facie* case of obviousness has not been

established with respect to claim 1, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

IV. Rejection of claims 2-7 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 2-7 under 35 U.S.C. § 103(a) as being unpatentable over Polizzi in view of Kukkal and further in view of Anuff. A *prima facie* case of obviousness has not been established.

As discussed above, Polizzi and Kukkal fail to teach or suggest a method including “presenting in the user’s personal workspace a workset that defines a user’s work role, the workset including at least one task and a working environment for performing the work role,” as recited in claim 1. Anuff does not overcome the deficiencies of Polizzi and Kukkal. That is, Anuff also fails to teach or suggest a method including “presenting in the user’s personal workspace a workset that defines a user’s work role, the workset including at least one task and a working environment for performing the work role,” as recited in claim 1, and required by claims 2-7 which depend from claim 1.

Accordingly, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claims 2-7. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, a *prima facie* case of obviousness has not been established with respect to dependent claims 2-7, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

V. Rejection of claims 10-15 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claims 10-15 under 35 U.S.C. § 103(a) as being unpatentable over Polizzi in view of Anuff. A *prima facie* case of obviousness has not been established.

As discussed above, Polizzi fails to teach or suggest a user interface tool configured to “present in the user’s personal workspace a workset that defines a user’s work role, the workset including at least one task and a working environment for performing the work role,” as recited in claim 9. Anuff does not overcome the deficiencies of Polizzi. That is, Anuff also fails to teach or suggest a user interface tool configured to “present in the user’s personal workspace a workset that defines a user’s work role, the workset including at least one task and a working environment for performing the work role,” as recited in claim 9, and required by claims 10-15 which depend from claim 9.

Accordingly, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claims 10-15. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, a *prima facie* case of obviousness has not been established with respect to dependent claims 10-15, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

VI. Rejection of claim 16 under 35 U.S.C. § 103(a)

Applicants respectfully traverse the rejection of claim 16 under 35 U.S.C. § 103(a) as being unpatentable over Polizzi in view of Kukkal. A *prima facie* case of obviousness has not been established.

As discussed above, Polizzi fails to teach or suggest a user interface tool configured to “present in the user’s personal workspace a workset that defines a user’s work role, the workset including at least one task and a working environment for performing the work role,” as recited in claim 9. Kukkal does not overcome the deficiencies of Polizzi. That is, Kukkal also fails to teach or suggest a user interface tool configured to “present in the user’s personal workspace a workset that defines a user’s work role, the workset including at least one task and a working environment for performing the work role,” as recited in claim 9, and required by claim 16 which depends from claim 9.

Accordingly, the Office Action has neither properly determined the scope and content of the prior art nor properly ascertained the differences between the prior art and the invention of claim 16. Thus, the Office Action has failed to clearly articulate a reason why the prior art would have rendered the claimed invention obvious to one of ordinary skill in the art. Accordingly, a *prima facie* case of obviousness has not been established with respect to dependent claim 16, and the rejection under 35 U.S.C. § 103(a) must be withdrawn.

VII. Conclusion

In view of the foregoing, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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